

## REMARKS

The Official Action dated November 25, 2008 has been received and its contents carefully noted. In view thereof, claim 1 has been amended in order to better define that which Applicants regard as the invention and new claim 8 has been added. No new matter has been introduced. Consequently, claims 1-8 are presently pending in the instant application with claim 1 being independent.

Initially, filed concurrently herewith are a Supplemental Application Data Sheet and a copy of the Reissue Application Declaration filed on April 22, 2004 and signed by the named inventors wherein language with respect to the error in the original Letters Patent is described and further expanded upon in detail herein. More specifically, the error referred to is the recitation of “wherein an edge portion of the capacitor electrode is formed onto the protective insulating film” set forth in column 15, lines 11-12 of U.S. Patent No. 6,441,420 which has been deleted as such recitation unduly narrowed the scope of the issued claim based on the prior art. Further, the recitation of the word “direct” before “connection” in column 15, line 19 of U.S. Patent No. 6,441,420 has likewise been deleted as such recitation unduly narrowed the scope of the issued claim based on the prior art. The inventors go on to state that all errors corrected in the Reissue Application arose without any deceptive intention on the part of the Applicant. Consequently, with the submission of Reissue Declaration executed by the inventors, it is respectfully submitted that the present application is now in proper formal condition for allowance.

With respect to the rejection of claims 1-7 under 35 U.S.C. § 251 as being an improper recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based. The Examiner asserts that “the claim limitation in the reissue which provides the broadening aspect, and which was not present in

the application for patent is ‘wherein an edge portion of the capacitor upper electrode is formed onto the protective insulating film.’ In the parent case 09/576791 (Attorney Docket No. 0819-379) the amendment filed 9/28/2001, which was in response to the non-final rejection mailed 7/2/2001, narrowed the scope of claim 1 by inserting the limitations ‘wherein an edge portion of the capacitor upper electrode is formed onto the protective insulating film’ between ‘protective insulating film’ and ‘a first contact.’ The amendment also inserted ‘the edge portion of’ between ‘second field-effect transistor and’ and ‘the capacitor upper electrode.’ This language was inserted in response to the 35 U.S.C. § 102(b) rejection over applicants admitted prior art.”

However, after telephonic interviews with the Examiner of record, the Examiner acknowledged that in the non-final rejection mailed 7/2/2001 the Section 102 rejection failed to properly address the limitation of “second contact plug formed in the protective insulating film” which improperly necessitated applicants’ amendments discussed above including the limitations of “wherein an edge portion of the capacitor upper electrode is formed onto the protective insulating film” and “the edge portion of” as well as “direct” as shown and deleted in amended claim 1 above. During the telephonic interview, the Examiner agreed that the reissue, as amended, was appropriate given the failure to address each and every claim limitation in the non-final rejection mailed 7/2/2001.

Thus, with respect to the rejection of claims 1-7, it is respectfully submitted that Applicants’ claimed invention as set forth in independent claim 1 as well as those claims which depend therefrom, is in proper condition for allowance.

Therefore, in view of the foregoing that it is respectfully requested that the objections of record be reconsidered and withdrawn by the Examiner, that the supplemental application data sheet and reissue declaration be reviewed and accepted by the Examiner, that claims 1-8

be allowed and that the application be passed to issue.

Should the Examiner believe a conference would be of benefit in expediting the prosecution of the instant application, he is hereby invited to telephone counsel to arrange such a conference.

Respectfully submitted,

/Sean A. Pryor, Reg. #48103/  
Sean A. Pryor  
Reg. No. 48,103

Nixon Peabody LLP  
401 9<sup>th</sup> Street N.W.  
Suite 900  
Washington, D. C. 20004  
(202) 585-8000